



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/859,705	05/17/2001	Michael Kai-Yin Au	YOR920000770US1	3974

7590 09/01/2004

Duke W. Yee
Carstens, Yee & Cahoon, LLP
P.O. Box 802334
Dallas, TX 75380

EXAMINER

LANEAU, RONALD

ART UNIT	PAPER NUMBER
----------	--------------

3627

DATE MAILED: 09/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/859,705	AU ET AL.	
	Examiner	Art Unit	
	Ronald Laneau	3627	<i>llw</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 33-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 33-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I (claims 1-16 and 33-47) is acknowledged. Claims 17-29, 30-32, 48-62 and 63-74 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant argues that the search and examination of all claims (1-16 and 33-47 (group I), 30-32 (group III) and 48-62 (group V)) could be made without serious burden. The examiner disagrees. Applicants have not traversed on the ground that the species are not patentably distinct. Furthermore, it is noted that "a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation *either* separate classification, separate status in the art, or a different field of search" (MPEP 803). Regarding the distinct inventions, only one showing is required and the examiner has shown by appropriate explanation separate status in the art. Also, the diverse species have a separate status in the art (separate inventive effort).

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3627

3. Claims 1-3, 6-8, 11-16, 33-35, 38, 39 and 42-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Westrope et al (US 5,721,832).

As per claims 1, 3, 8, 11-16, 33-35, 38, 39, and 42-47, Westrope et al teach a method in a primary data processing system (catalog data processor 67) for managing a catalog (col. 7, lines 13-15), the method comprising: sending a catalog and user information to a plurality of secondary data processing system located in a network data processing system (marketing data processor 75); allocating inventory associated with the catalog to the plurality of secondary processing systems (inventory memory 107); receiving an order from one of the plurality of secondary data processing systems (col. 7, lines 23-26); and processing the order, in response to receiving the order (col. 7, lines 28-30).

As per claim 2, Westrope et al teach a system that sends an update to the catalog to the plurality of secondary data processing systems as claimed (col. 9, lines 57-61).

As per claims 6, 7, 38, and 39, Westrope et al teach a system that inherently teaches a shopping card data (items ordered by the user are stored in a safe place) from the secondary data processing system as claimed.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3627

5. Claims 4, 5, 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Westrope et al (US 5,721,832).

As per claims 4, 5, 36 and 37, Westrope et al do not teach allocation of the inventory upon a detection of a condition which is a threshold but it is well known to set a condition when determining whether or not an inventory is necessary because it would help determining the location of missing products, the examiner takes Official notice as such.

6. Claims 9, 10, 40, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Westrope et al (US 5,721,832) in view of Yamazoe et al (US 2001/0032148).

As per claims 9, 10, 40 and 41, Westrope et al do not teach a catalog that is sent in a markup language and wherein the markup language is extensible markup language but Yamazoe et al teach an application service on a network having a WWW (World Wide Web) voluntarily managed by the selling enterprise through the use of the XML (extensible markup language).

It would have been obvious to one of ordinary skill in the art to utilize the extensible markup language (XML format) taught by Yamazoe et al into the system of Westrope et al because it would ensure a safe transmission of the information or document through a network.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 3627

- Au et al (US 2002/0174034) teach a method and apparatus for a distributed web commerce system.
- Nelson (US 2002/0111877) teaches a system and method for managing retail and wholesale operations.
- Swanson (US 2002/018111) teaches an intelligent multi-media e-catalog.
- Cihla et al (US 2002/0128204) teach systems for procuring products in a distributed system.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (703) 305-3973. The examiner can normally be reached on Mon-Fri from 8:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RL
Ronald Laneau
Examiner
Art Unit 3627

*Handwritten signature: Ronald Laneau 8/30/04
Primary Examiner*